

REMARKS

In the Office Action mailed September 13, 2004, the Examiner has rejected pending claims 1-20. New claims 21 and 22 have been added. No new matter has been added. Support for new claim 21 can be found in the specification at page 19, line 3 through page 20, line 1. Support for new claim 22 can be found throughout the specification. Thus, in view of the foregoing, claims 1-20 remain pending for reconsideration, which is respectfully requested. Consideration of pending claims 21 and 22 is also respectfully requested. The Examiner's rejections are traversed below.

Claim Objections

At item 2 of the Office Action, the Examiner has objected to claims 11, 16 and 20 because "they contain minor typographical errors at lines 7, 9 & 8 of claims 11, 16 & 20 respectively after the word "to" delete the word —an—[sic]." See Office Action, at page 1.

Applicants have amended the claims to correct the typographical errors, as requested by the Examiner.

Claim Rejections under 35 U.S.C. §103

At item 3 of the Office Action, the Examiner has rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,057,915, issued to Von Kohorn (hereinafter Von Kohorn). See Office Action, at page 2.

Von Kohorn discloses a system for the evaluation of responses to broadcast and prerecorded programs. According to Von Kohorn, the system provides for the transmission of signals designating questions and response criteria along with a transmission of the broadcast program. See Von Kohorn, column 2, at lines 23-29.

The Examiner has asserted that Von Kohorn discloses, 'viewers . . . who are in a time zone . . . inform member [sic] of an audience in another time zone of the correct responses. . . thus ensuring such members in other time zones of winning an award . . .'. The Examiner has informed Applicants that he "interprets these disclosures and whole document" of Von Kohorn as showing,

A method of providing points based on a retrieval of keywords, the method comprising the steps of:

presenting keywords to a first user through a network, and storing keywords selected by the user into a user-by-keyword management table relating to the user;

presenting keywords to an advertiser through the network, and storing keywords selected by the advertiser into an advertiser-by-keyword management table relating to the advertiser;

searching the user-by-keyword management table and the

advertiser-by-keyword management table for keywords when there has been a request for retrieving the keywords from a second user different from the first user through the network, and when the requested keywords have been registered both in the user-by-keyword management table and the advertiser-by-keyword management table, posting a retrieved result of the keywords and advertisement of the corresponding advertiser to the second user through the network; and

giving points to the first user when the second user has referred to the advertisement, and storing these points into a user's-point management table relating to the first user.

, as recited by independent claim 1.

Although the Examiner acknowledges that Von Kohorn lacks an explicit recitation of "some of the keyword management table elements and limitations," the Examiner concludes that it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Von Kohorn "implicitly shows all the elements and limitations of claim 1." See Office Action, at Page 3.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness. The burden of establishing a *prima facie* case of obviousness based upon the prior art lies with the Examiner. In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992). According to In re Fritch, the Examiner "... can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In an attempt to satisfy the above-identified burden of establishing a *prima facie* case of obviousness, the Examiner may rely on implicit or inherent disclosures of a reference. See In re Napier, 55 F.3d 610, 613, 34 USPQ.2d 1782,1784 (Fed. Cir. 1995). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769,775 (Fed. Cir. 1983). See also Manual of Patenting Examining Procedure (MPEP), chapter 2112, IV. The fact that a certain result or characteristic *may* occur or be present in the "prior art" is not sufficient to establish inherency of that result or characteristic. See In re Oelrich, 666 F.2d 578,581-82, 212 USPQ 323, 326 (CCPA 1981). Rather,

to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In relying on the theory of inherency, 'the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art [emphasis added].' See MPEP, chapter 2112, IV, citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Applicants respectfully submit that the Examiner has not provided "a basis in fact and/or technical reasoning" to reasonably support the determination that the allegedly inherent characteristics, that is, the elements of claim 1, **necessarily flow** from the teachings of the applied prior art. See *id.*

Rather, the Examiner has simply concluded that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Von Kohorn implicitly shows all the elements and limitations of claim 1." See Office Action, at Page 3.

The Examiner has also concluded that,

It would have been obvious to modify and interpret the disclosure of Von Kohorn cited above as showing all of the keyword management table elements and limitations of claim 1, because modification and interpretation of the cited disclosure of Von Kohorn would have provided broad means to 'increase the audience . . .' (see Von Kohorn (col. 2, ll. 40-45)), based on the motivation to modify Von Kohorn so as to create added interest and excitement among . . . viewers . . . (See Von Kohorn (col. 2, ll. 35-45)).

See Office Action, at page 3.

Applicants respectfully submit that the mere fact that Von Kohorn **can be** modified is not sufficient to establish a *prima facie* case of obviousness. See *In re Mills*, 916 F.2d 680, 16 USPQ2D 1430 (Fed. Cir. 1990) (holding that although "a prior art device may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so").

Applicants respectfully submit that unlike the present invention, the cited reference Von Kohorn does not teach or suggest the elements of independent claim 1. For example, Von Kohorn does not teach or suggest "giving points to the first user when the second user has referred to the advertisement and storing these points into a user's-point management table relating to the first user," as recited by independent claim 1. In the present invention, when a second user has searched a table using keywords that have been registered in a user-by-keyword management table and an advertiser-by-keyword management table, respectively, the

server displays the advertising of the advertiser relating to the keyword registered in the advertisement-by-keyword management table at a terminal of the second user. See Specification of the Present Invention, Page 2, line 17 – page 3, line 19. Consequently, service providers in the present invention can provide a user-participation type business system that involves end users, thereby expanding their business. See Specification of the Present Invention, page 34, lines 16-19.

Rather, Von Kohorn relates to the provision of signals designating questions or tasks to response criteria for evaluating responses of listeners and viewers of a broadcast or prerecorded program and to the dispensing of awards to individual listeners and viewers having provided answers meeting the response criteria. See Von Kohorn, column 1, lines 15 – 25.

Therefore, withdrawal of the rejection is respectfully requested. Claim 1 of the present invention is patentable over Von Kohorn, in light of the foregoing. Claims 2-8 depend from claim 1 and are thus patentable over Von Kohorn for at least the reason offered above with respect to claim 1, in addition to additional reasons.

For example, claim 4 recites, in relevant part, “wherein the selection of the keywords is free of charge, and the users can select the free keywords at the time of making a contract on the utilization of a network service.” Applicants submit that Von Kohorn does not teach or suggest the feature identified by the above-quoted language of dependent claim 4. Rather, Von Kohorn merely discloses a system that provides for the transmission of signals designating questions and response criteria along with a transmission of a broadcast program. Therefore, dependent claim 4 is patentable over Kohorn for the above-identified reason, in addition to the reason identified with respect to claim 1.

The Examiner has taken official notice regarding the concepts and the advantages of the elements of dependent claim 4 and has used the rationale applied with respect to claim 1 to reject the dependent claim.

It is well-established that it is “**not** appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” See MPEP, chapter 2144.03, A. Applicants respectfully submit that the Examiner has not cited a prior art reference, as the facts alleged by the Examiner to be well known are “not capable of instant and unquestionable demonstration as being well-known.”

Independent claims 9-20 recite, in relevant part, language similar to that of independent claim 1. Thus, Applicants submit that claims 9-20 are patentable over Von Kohorn for at least the reason offered above with respect to independent claim 1.

Applicants submit that new method claim 21 is also patentable over Von Kohorn, as Von Kohorn does not teach or suggest,

allowing the advertisers to select optional charged keywords from the list of the charged keywords and to apply for the registration of the charged keywords; setting content of contracts made by the advertisers and a provider of the method; and receiving advertising data corresponding to the charged keywords from the advertisers.

, as recited by claim 21. As discussed above, Von Kohorn merely discloses a system for the evaluation of responses to broadcast and prerecorded programs. In addition, Applicants submit that new method claim 22 is patentable over Von Kohorn, as Von Kohorn does not teach or suggest any of the features recited by its language.

CONCLUSION

In light of the foregoing, claims 1-22 are in condition suitable for allowance. An early Notice of Allowance is respectfully requested. If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the USPTO is requested to obtain the same from deposit account number 19-3935.

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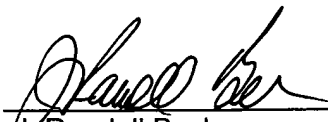
Respectfully submitted,

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